



HJD  
Docket No. 13761-7001

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Pursuant to 37 C.F.R. § 1.8, I hereby certify that this paper and all enclosures are being deposited with the United States Postal Service as first class mail on the date indicated below in an envelope addressed to the Assistant Commissioner for Patents, Washington D.C. 20231.

Pursuant to 37 C.F.R. § 1.6(d), I hereby certify that this paper and all enclosures are being sent via facsimile on the date indicated below to the attention of Examiner \_\_\_\_\_ at Facsimile No. \_\_\_\_\_ at \_\_\_\_\_ a.m./p.m.

Dated: January 7, 2002

Name of Person Certifying:

Printed Name: Laer Barrett

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lenz, et al.

Assignee: University of Southern California

Filing Date: 04/02/01

Examiner: Myers, C.

Serial No.: 09/824,629

Group Art Unit: 1655

Title: MANGANESE SUPEROXIDE DISMUTASE GENE POLYMORPHISM FOR PREDICTING CANCER SUSCEPTIBILITY

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121

Assistant Commissioner for Patents  
Washington, D.C. 20231

A petition for a one month extension of time accompanies this response.

This is in response to the restriction requirement set forth in the Office Action mailed on November 7, 2001. In the Office Action, the Examiner identified two claim groups and required the election of one claim group for prosecution in the present application. The two claim groups are as follows:

- I. Claims 1-12, "drawn to kits comprising oligonucleotides, classified in class 536, subclass 24.31." **(The Examiner lists claims 5-12 in Group I but that appears to be typographical error.)**
- II. Claims 13-30, "drawn to methods of diagnosing risk of colorectal cancer, classified in class 435, subclass 6."

Applicants hereby elect Group II, Claims 13-30 for examination with traverse, and requests reconsideration of the requirement for the following reasons.

The Commissioner may require restriction only when the inventions are independent or distinct, and examination without restriction presents a serious burden to the examiner. See MPEP § 803. Examiners must provide reasons and/or examples to support their conclusions regarding the status of the inventions and the seriousness of the burden. Id. Applicants respectfully submit that a review of the specification and the claims indicates that the two claim groups identified by the Examiner are closely linked as a unitary invention and should be examined together, notwithstanding the Examiner's assertion to the contrary.

According to the MPEP guidelines designed to determine whether inventions are *independent* from others, the term "independent" means that there is no disclosed relationship between the subject matter, that is, "they are unconnected in design, operation, or effect." See MPEP § 802.01. Examples of independent combinations are "an article of apparel such as a shoe, and a locomotive bearing," or "a process of painting a house and a process of boring a well." See MPEP § 806.04. As noted above, Claim Groups I and II are related to each other because they both relate to identification of the molecular structure of the MnSOD gene.

Although the Examiner is correct in stating that Group I claims are directed to a product and Group II claims are directed to a method of use, the Examiner has not shown that the kits of Group I can be used in a materially different process. The Examiner asserts that the kits can be used in methods for diagnosing other cancers, such as breast cancer but the Examiner provides no basis for making that assertion. Therefore, the Examiner has not made the requisite showing to impose the above restriction requirement.

For all of the foregoing reasons, Applicants respectfully submit that the inventions of Groups I and II are closely related and not independent and, therefore, there is no basis for imposing upon Applicants the added expense of filing and prosecuting an additional application. Applicants, therefore, respectfully request reconsideration of the restriction requirement between Claim Groups I and II, and ask that it be withdrawn, and further request an action on the merits and a notice of allowance.

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 50-1192.

Dated: January 7, 2002

Respectfully submitted,

McCutchen, Doyle, Brown & Enersen, LLP

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